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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,063	07/26/2000	Louri Brylov	10001122.1	8584

22879 7590 10/05/2004

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EXAMINER

PARK, CHAN S

ART UNIT PAPER NUMBER

2622

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/626,063	Applicant(s) BRYLOV, LOURI	
	Examiner CHAN S PARK	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 6/29/04, and has been entered and made of record. Currently, **claims 25-48** are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 25-48 have been considered but are moot in view of the new ground(s) of rejection.

Specification

3. The correction to the Specification is acceptable and thus the objection is withdrawn.

Claim Objections

4. Claim 33 is objected to because of the following informalities: perhaps "said storing" should be "said opening connection". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 27 and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Referring to pg 9, lines 19-21 of the Specification, it is unclear how the document icon is initially created to represent and to distinguish a particular document. The specification teaches that the document is scanned *after* the drag-and-drop operation. Thus, it is unclear how a document icon can be initially created *before* any scanning operation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 27 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Due to the lack of enablement requirement addressed above, it is unclear how document icon can be initially created before any scanning operation as it is claimed in claims 27 and 38.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25, 26, 29-33, 35-37, 40, 41, 43, 47 and 48 are rejected under 35

U.S.C. 102(e) as being anticipated by Nagasaka et al. U.S. Patent No. 6,556,875

(hereinafter Nagasaka).

7. With respect to claim 25, Nagasaka teaches the method of scanning an image to a location, the method comprising:

detecting a drag and drop operation wherein a first icon is dragged to a location indicator and dropped on said location indicator (col. 21, lines 5-17 and fig. 7B);

opening a connection between a scanner associated with said first icon and said location, wherein said location is associated with said location indicator (col. 20, lines 58-63 and S114 in fig. 24);

causing said scanner to scan said image (col. 22, lines 7-17 and col. 26, lines 3-22); and

storing said image in said location (fig. 3A; col. 17, lines 30-37; and col. 22, lines 60-64).

Referring to fig. 3A, Nagasaka teaches that the buffer in device driver 32b can be part of the destination device 41. Additionally, a printer buffer or RAM in a printer is an inherent feature (unless the printer is real-time printer) since the printer has to store to the received print data either permanently or temporarily for rendering.

Furthermore, since the destination device can be either facsimile or electronic mail device (col. 22, lines 60-64), the received data must be stored for further process (displaying the email or transmitting the image).

8. With respect to claim 26, Nagasaka teaches the method of claim 25, wherein said first icon comprises a scanner icon (fig. 7B).

9. With respect to claim 29, Nagasaka teaches the method of claim 25, wherein said location indicator comprises an icon (fig. 7B).

10. With respect to claim 30, Nagasaka teaches the method of claim 25, wherein said location indicator comprises a server icon (col. 3, lines 9-27).

11. With respect to claim 31, Nagasaka teaches the method of claim 25, wherein said location indicator comprises a text listing for said location (figs. 7 & 20).

12. With respect to claim 32, Nagasaka teaches the method of claim 25, further comprising automatically converting said image to a different document format before said storing (col. 19, lines 1-12). Since the image processing server does the converting, the conversion is automatic.

13. With respect to claim 33, Nagasaka teaches the method of claim 25, wherein said storing/opening comprises transferring said image across said connection (col. 20, lines 58-63 and col. 32, lines 20-29).

14. With respect to claim 35, Nagasaka discloses an apparatus for controlling an image scanning process, comprising:

- a. at least one computer readable medium (software in col. 3, lines 9-12);
- and

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b. computer readable program code stored on said at least one computer readable medium, said computer readable program code being automatically executed when a first displayed element is dragged to and dropped upon a second displayed element (col. 21, lines 5-17; col. 32, lines 20-29; and fig. 7B), said computer readable program code comprising:

- i. program code for establishing a connection between a scanner associated with said first displayed element and a destination storage location associated with said second displayed element (col. 20, lines 58-63 and col. 32, lines 20-29);
- ii. program code for causing said scanner to scan at least one image (col. 26, lines 3-22); and
- iii. program code for transferring said at least one image from said scanner to said destination storage location and storing said at least one image in said destination storage location (fig. 3A; col. 3, lines 9-27; col. 17, lines 30-37; and col. 22, lines 60-64).

Referring to fig. 3A, Nagasaka teaches that the buffer in device driver 32b can be part of the destination device 41. Additionally, a printer buffer or RAM in a printer is an inherent feature (unless the printer is real-time printer) since the printer has to store to the received print data either permanently or temporarily for rendering.

Furthermore, since the destination device can be either facsimile or electronic mail device (col. 22, lines 60-64), the received data must be stored for further process (displaying the email or transmitting the image).

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15. With respect to claim 36, Nagasaka discloses the apparatus of claim 35, wherein said computer readable program code is executed without further user intervention after said first displayed element is dragged to and dropped upon said second displayed element (col. 22, lines 7-17 and col. 26, lines 3-22).

16. With respect to claim 37, Nagasaka discloses the apparatus of claim 35, wherein said first displayed element comprises a scanner icon (fig. 7B).

17. With respect to claim 40, Nagasaka discloses the apparatus of claim 35, wherein said second displayed element comprises a server icon (col. 3, lines 9-27).

18. With respect to claim 41, Nagasaka discloses the apparatus of claim 35, wherein said second displayed element comprises a text listing for said location (figs. 7 & 20).

19. With respect to claim 43, Nagasaka discloses the apparatus of claim 35, said computer readable program code further comprising program code for converting said at least one image to a different document format before said transferring and said storing (col. 19, lines 1-12). The conversion is performed before the data transfer from image processing server D to printer D in fig. 18.

20. With respect to claim 47, Nagasaka discloses the apparatus of claim 35, said computer readable program code further comprising program code for determining if said destination storage location is a supported location (col. 22, lines 7-17 and col. 26, lines 3-19).

21. With respect to claim 48, Nagasaka discloses an apparatus for scanning and transferring images, comprising:

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means for detecting a drag-and-drop of a scanner-related icon to a location-related icon (col. 21, lines 5-17; col. 32, lines 20-29; and fig. 7B);

means for automatically causing a scanner associated with said scanner-related icon to scan at least one image when said drag-and-drop is detected (col. 22, lines 7-17 and col. 26, lines 3-22); and

means for automatically transferring said at least one image to a storage location associated with said location-related icon when said scan of said at least one image is complete (col. 20, lines 58-63, S114 in fig. 24 & fig. 33).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasaka as applied to claim 25 above, and further in view of Machida U.S. Patent No. 6,642,943.

22. With respect to claim 27, Nagasaka teaches the method of claim 25, wherein said first icon comprises a document icon for a document in a digital camera (fig. 33).

Nagasaka does not teach expressly that the first icon comprises a document icon for a document in said scanner.

Machida, the same field of endeavor of drag-and-drop system, teaches a document icon for a document in said scanner (col. 10, lines 11-12; 302d in fig. 5; and figs. 13 & 14).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the document icon for a document in said scanner of Machida into the drag-and-drop system of Nagasaka.

The suggestion/motivation for doing so would have been to inform the user that a document is present in the scanner.

Therefore, it would have been obvious to combine Nagasaka with Machida to obtain the invention as specified in claim 27.

23. With respect to claim 28, Nagasaka teaches the method of claim 25, but it does not teach expressly that the first icon comprises an ADF icon for ADF in said scanner.

Machida, the same field of endeavor of drag-and-drop system, teaches an ADF icon for an ADF in a scanner (col. 28, lines 10-13).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the ADF icon for a ADF in said scanner of Machida into the drag-and-drop system of Nagasaka.

The suggestion/motivation for doing so would have been to inform the user that an ADF is present in the scanner.

Therefore, it would have been obvious to combine Nagasaka with Machida to obtain the invention as specified in claim 28.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasaka as applied to claim 25 above, and further in view of Lamming et al. U.S. Patent No. 5,862,321 (hereinafter Lamming).

24. With respect to claim 34, Nagasaka teaches the method of claim 25, but it does not teach expressly that the connection is an FTP connection.

Lamming, the same field of endeavor of scanned image transfer, teaches a network connection using an FTP connection (col. 5, lines 12-16).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the FTP connection of Lamming into the drag-and-drop system of Nagasaka.

The suggestion/motivation for doing so would have been to transfer the scanned image or documents on the Internet.

Therefore, it would have been obvious to combine Nagasaka with Lamming to obtain the invention as specified in claim 34.

Claims 38, 39 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasaka as applied to claim 35 above, and further in view of Machida.

25. With respect to claim 38, arguments analogous to those presented for claim 27, are applicable.

26. With respect to claim 39, arguments analogous to those presented for claim 28, are applicable.

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27. With respect to claim 42, Nagasaka discloses the apparatus of claim 35, but it does not disclose expressly that the second displayed element comprises a folder icon.

Machida, the same field of endeavor of drag-and-drop system, discloses a folder icon for the destination icon (col. 37, line 60 – col. 38, line 5).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the folder icon of Machida into the drag-and-drop system of Nagasaka.

The suggestion/motivation for doing so would have been to properly transfer the scanned document to a correct location or folder.

Therefore, it would have been obvious to combine Nagasaka with Machida to obtain the invention as specified in claim 38.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasaka as applied to claim 35 above, and further in view of Lamming.

28. With respect to claim 44, arguments analogous to those presented for claim 34, are applicable.

Claims 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasaka as applied to claim 35 above, and further in view of Watanabe.

29. With respect to claims 45 and 46, Nagasaka teaches the method of claim 35 but it does not teach expressly the method of determining if an ADF is connected to said scanner.

Watanabe, the same field of endeavor of scanner, teaches the method of determining if an ADF is connected to a scanner. When the ADF is not connected to the scanner, a control unit 100 in an image forming apparatus decides to scan an image directly placed on the glass of scanner unit 101 (default scanning mode) (col. 6, line 61 – col. 7, line 3).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the method of determining the presence of the ADF taught by Watanabe with the scanner of Nagasaka.

The suggestion/motivation for doing so would have been to scan image data from the ADF when the ADF is connected in the system.

Therefore, it would have been obvious to combine Machida and Watanabe to obtain the invention as specified in claims 45 and 46.

Conclusion

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp
September 30, 2004

Chan S. Park
Examiner
Art Unit 2622

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